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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/246,695	02/09/1999	MICHITO WATANABE	2091-0186P-S	6491

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EXAMINER

FLYNN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 01/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/246,695

Applicant(s)

WATANABE ET AL.

Examiner

Kimberly D Flynn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

1. This action is in response to Applicant's amendment and request for reconsideration filed on July 30, 2001. Claims 1-15 are presented for further consideration.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle (U.S. Patent No. 6,133,985) in view of Puralski (EPO 0860980 A2).

In considering claims 1,4,6,8,11, and 12, Garfinkle discloses a system comprising:

- *Image storing means for storing a plurality of image (See, col. 6, lines 64-67);*
- *Image selecting means for enabling a service user to select at least one of the plurality of stored images, by enabling the stored images to be view on the network (See, col. 4, lines 7-13 and col. 7, lines 5-10);*
- *Mail generating means for generating an electronic mail message with the selected image as an attachment to the electronic mail message, without*

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requiring a recipient of the electronic mail with attached image to activate an address that point the recipient to a file which stores the selected image (col. 5, lines 25-28 and col. 7, lines 10-16);

- *Destination address specifying means for enabling the service user to specify a destination address of the electronic mail message (See Fig 5C); and*
- *Mail transmitting means for transmitting the electronic mail message to the destination address specified by the destination address specifying means (See Fig 5C).*

In considering claims 2,7, and 13, although the system taught by Garfinkle discloses substantial features of the claimed invention, it fails to disclose a comment inputting means for enabling the service user to input a comment on the image selected by the image selecting means, wherein the mail generating means generates an electronic mail message including the input comment as text. However, inputting comments on digital images is well known as taught by Parulski. In similar art, Parulski discloses wherein a user can input one or more text messages onto the digital images (See Fig. 3, and Pg. 3, lines 25-27). Thus, given the teaching of Parulski a person having ordinary skill in the art would have found it desirable, as well as advantageous, to include the comment inputting so that the user could have more creative options when processing their digital images. Therefore, the claimed limitation, would have been an obvious modification to the system taught by Garfinkle.

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In considering claim 3 and 14, although the system taught by Garfinkle discloses substantial features of the claimed invention, it fails to disclose an attachment mode selecting means for enabling the service user to select an attachment mode by presenting a plurality of attachment modes as formats for attaching the image, wherein the mail generating means attaches the image according to the attachment mode selected by the attachment mode selecting means. Nonetheless, means for enabling the service user to select an attachment mode as a format for attaching images to email is well known as evidenced by Parulski.

In similar art, Parulski discloses an image detail section that describes different file types (e.g. FlashPix, JPEG, TIFF) for attaching images (See Fig. 4, and Pg. 4, lines 56-57). Thus, given the teaching of Parulski, a person having ordinary skill in the art would have readily recognized the desirability and advantages of including the attachment mode selecting means taught by Parulski in the digital image processing system taught by Garfinkle so that the user could choose the appropriate format to send the image in order to minimize bandwidth and allow faster transfer over the network. Therefore, the claimed limitation, would have been an obvious modification to the system taught by Garfinkle.

In considering claims 5,9,and 15, although the system taught by Garfinkle discloses substantial features of the claimed invention, it fails to disclose a user address setting means for enabling the service user to set their electronic mail address thereof, characterized by that the mail transmitting means describes the mail address set by the

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user address setting means as the address of the sender of the electronic mail message. However, Examiner takes official notice that means for enabling a user to set their electronic mail address as the sender of the electronic mail is a well-known feature of electronic mail. It would have been obvious to a person having ordinary skill in the art to include the address setting means in the system taught by Garfinkle so the recipient of the electronic mail would know from whom the electronic message was sent. Therefore, the claimed limitation, would have an obvious modification to the system taught by Garfinkle.

In considering claim 10, Garfinkle further discloses a system comprising:

- *displaying a plurality of selectable images to be transmitted from a user of the system to a recipient as an attachment to an electronic mail message on the center server, for viewing by the user on a device of the user that is in communication with the center server (See Fig. 5C (5e) and col. 7, lines 5-8);*
- *selecting at least one of the plurality of selectable images at the user's device; reading an image file corresponding to the selected image from a memory at the server (See Fig. 5C and col. 7, lines 8-10);*
- *converting the read image file into an attachment document format for the electronic mail message (col. 5, lines 35-40); and*
- *transmitting the electronic mail message with attached image to the recipient (See Fig. 5C and col. 7, lines 11-15).*

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Response to Arguments

In response to Applicant's remarks filed on July 30, 2001, the following factual arguments are noted:

- (a). Parulaski et al. fails to teach or suggest at least the feature of "generating an electronic mail message with a selected image as an attachment to the electronic mail message, without requiring a recipient of the electronic mail with attached image to activate an address that points the recipient to a file which stores the selected image".
- (b). Parulaski et al. does not discuss enabling a user to select the desired attached mode for sending the image as an attachment with the email message.
- (c). Parulaski et al. does not teach or suggest the feature of allowing the user to set their own "send address" which is indicated in the email message with a message which the attached image was sent from.

In considering (a), Applicant contends that Parulaski et al. fails to teach or suggest at least the feature of "generating an electronic mail message with a selected image as an attachment to the electronic mail message, without requiring a recipient of the electronic mail with attached image to activate an address that points the recipient to a file which stores the selected image". Examiner disagrees. The teaching of Parulaski (page 2, lines 49-53) clearly states that the utilization file, which can be

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transmitted to the print service provider, can alternately include e-mail addresses to allow images to be automatically sent to others. Nowhere does it state that the user must activate an address that points to the file, which stores the image. Examiner maintains that the teaching of Parulaski reads on the claimed limitation.

In considering (b) Applicant contends that Parulaski et al. does not discuss enabling a user to select the desired attached mode for sending the image as an attachment with the email message. Examiner disagrees. The teaching of Parulaski (page 4, lines 56-57) describes an image detail section as part of the software that enables the user to send images. This section includes file types of the images (e.g. FlashPix, JPEG, and TIFF), which are all ways of attaching images to email. Examiner maintains that the teaching of Parulaski reads on the claimed limitation.

In considering (c) Applicant contends that Parulaski et al. does not teach or suggest the feature of allowing the user to set their own "send address" which is indicated in the email message with a message which the attached image was sent from. Examiner disagrees. The teaching of Parulaski (page 3, lines 22-24) clearly states that the software application provided with the camera allows the user to specify names of downstream service providers, network addresses (friends, family, or business associates) and related account information. Therefore, Examiner maintains that the teaching of Parulaski reads on the claimed limitation.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. Pat No. 5,881,233 to Toyoda

An electronic mail system comprising an apparatus connected to a network capable of transmitting image data of the electronic-mail format toward the electronic-mail destination address via a network.

- U.S. Pat. No. 5,605,153 to Fujioka

A medical image diagnostic system comprising an image collecting section, an image storing section, and an image processing section, the system further includes a determining section and an adding section.

- U.S. Pat. No. 6,028,982 to Toyoda

An image communicating method, facsimile type electronic mail apparatus and facsimile apparatus that comprises a method and apparatus for changing image data to mail data to be transmitted from a transmitting side to a receiving side through a LAN by electronic mail.

- U.S. Pat No. 6,124,939 to Toyoda

An electronic mail system that includes a section for converting image data into an electronic mail format, a section for receiving information of an electronic-mail

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destination address, and a section for transmitting the image data of the electronic mail format toward the electronic-mail destination address via the network

- U.S. Pat. No. 6,138,149 to Ohmura

A system for tracking information copied from a web page and sent via electronic mail comprising an electronic mail editing section that has a function of editing electronic mail and inserting a stored index sticker into the text of the electronic mail.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Flynn whose telephone number is 703-308-7609. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:30 PM.

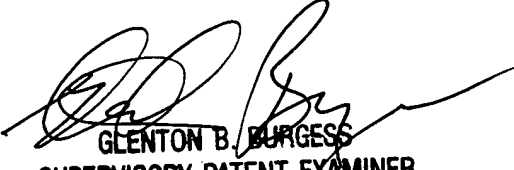
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7201 for regular communications and 703-308-7201 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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Kimberly D Flynn
Examiner
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KF
January 28, 2002



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